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Appl. No.: 09/876,760

Confirmation No.: 2221

Applicant(s): Scheuber et al.

Filed: June 7, 2001

Art Unit: 2854

Examiner: J. E. Culler

Title: METHOD AND APPARATUS FOR PROVIDING TEXT ON PRINTED
PRODUCTS

Docket No.: 034183/233887

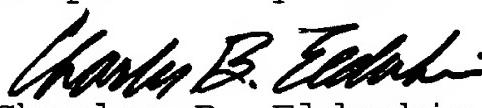
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APPEAL BRIEF TRANSMITTAL
(PATENT APPLICATION - 37 C.F.R. § 41.37)

1. Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on July 19, 2004.
2. Applicant claims small entity status.
3. Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:
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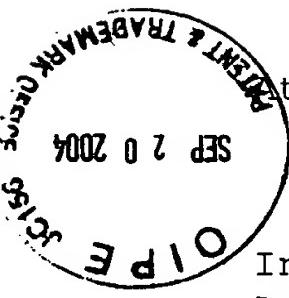
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Joyce D. Smith



Attorney's Docket No. 034183/233887

AF/2854/2rc
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Scheuber et al. Confirmation No.: 2221
Appl. No.: 09/876,760 Group Art Unit: 2854
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APPEAL BRIEF UNDER 37 CFR § 1.192

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed July 19, 2004.

1. Real Party in Interest.

The real party in interest in this appeal is Ferag AG, located in Hinwil, Switzerland, the assignee of the above-referenced patent application, as evidenced by the Assignment recorded at Reel 9180, Frame 0650 on May 14, 1998 in parent application 09/078,914 (now Patent No. 6,695,028).

2. Related Appeals and Interferences.

Appeal No. 2002-2125 was filed in the parent application 09/078,914 on August 22, 2001, and was decided on May 23, 2003. The parent application issued as Patent No. 6,695,028 on February 24, 2004.

3. Status of Claims.

The claims under appeal are Claims 5-14 which are reproduced in the Appendix to this Brief. Claims 1-4 are cancelled.

4. Status of Amendments.

No amendments have been filed since the final Office Action dated April 16, 2004, and there are no exhibits.

5. Summary of the Invention.

Broadly stated, the present invention relates to a method and apparatus for applying printed text, such as an address label, in an exposed border region which contains printing, of each of a plurality of printed products moving in an imbricated, i.e. partially overlapping, stream of the products. The invention achieves the highly desirable and novel result of assuring that both the underlying printed text and the printing on the label can be seen and read.

In the embodiment recited in the claims of present application, the text is applied by printing a partially transparent contrast panel onto the exposed border region of each printed product, using for example a partially transparent white ink, note page 6, lines 20-23 of the specification of the present application. The text is then formed within or on each contrast panel, such as by printing the contrast panel or forming blank areas within the contrast panel.

The phrase "partially transparent contrast panel" is defined in the specification and claims as forming a good contrast with the information formed thereon and also allowing the underlying printed information to be seen and read, note particularly the paragraph beginning at page 3, line 32, and the paragraph beginning at page 6, line 16 of the specification. Also, Figure 2 illustrates a partially transparent contrast panel at 14, and as indicated the underlying printed information 10' can be seen therethrough, and the printed text 18 on the panel is clearly visible.

Independent method Claim 5 defines the invention substantially as described above, and independent method Claim 8 is specific to an embodiment wherein the step of applying the partially transparent contrast panel to the exposed border region of each printed product, involves printing the contrast panel so as to overlie the printing on the printed surface of the product and so as to allow the printing on the printed surface to be seen therethrough.

Independent apparatus Claim 11 defines the invention so as to include a conveyor system **24** for conveying the printed products **10** in an overlapping imbricated stream, and as seen in Fig. 7, a label printing means **28** for printing the partially transparent contrast panel **14** as defined above to the exposed border region of each product.

6. **Issues.**

Are Claims 5, 7-8, 10-11 and 13 each unpatentable under §103 of the Patent Statute over Mowry Patent No. 4,681,348 in view of Fröhlich Patent No. 4,983,990?

Are Claims 6, 9, and 12 each unpatentable under §103 of the Patent Statute over Mowry in view of Fröhlich and further in view of Gurwich Patent No. 2,084,026?

Is Claim 14 unpatentable under §103 of the Patent Statute over Mowry in view of Fröhlich and further in view of Reist Patent No. 4,538,161?

Are Claims 5-13 each unpatentable under §103 of the Patent Statute over "A Century of Comics" in view of Fröhlich?

Is Claim 14 unpatentable under §103 of the Patent Statute over "A Century of Comics" in view of Fröhlich and further in view of Reist?

7. Grouping of Claims.

For purposes of this Appeal, the claims of each of the following two groups of claims may be considered to stand or fall together, and the groups are considered to be separately patentable from each other and do not stand or fall together, for the reasons specified in the Argument section of this Brief.

1. Claims 5-7 and 11-14
2. Claims 8-10

8. Argument.

Claims 5, 7-8, 10-11 and 13 stand rejected as being unpatentable over Mowry in view of Fröhlich.

The subject matter of the cited prior patent to Mowry relates to a financial document, i.e. a check or a money order, which is protected against alteration. The document includes an amount receiving area 20 and an area 26 for carrying a message. The areas 20 and 26 are coated with layers 50 and 52 respectively of self-contained pressure sensitive image forming chemicals. The chemicals are released from frangible capsules (column 1, lines 59-65) upon application of pressure exerted by a printer, then react and form the printed numerals and characters in the areas 20 and 26.

It is submitted that the subject matter of the Mowry patent as summarized above is outside the field of technology to which the present invention relates and it is unrelated to the problem solved by the present invention. As such, the Mowry patent must be considered non-analogous art and it should not be employed in the obviousness determination as defined by 35 USC §103, see *In re Wood*, 202 USPQ 171 (CCPA 1979).

More particularly, the field of technology of the present invention relates to methods and apparatus for providing individualized text, e.g. address labels, on newspapers, periodicals and similar printed products which are being processed at high speeds in an imbricated stream. Mowry on the other hand relates to the field of financial documents which are designed to protect against alteration. One skilled in the former field of technology would not have looked to the latter field of technology in dealing with the problem associated with applying address labels to printed products which are being processed in an imbricated stream at high speeds.

In the latest Official Action, the Examiner has attempted to respond to the above contention by broadly defining the field of technology as "printing" and defining the problem as "printing information in more than one layer", note paragraph 7 of the Official Action of April 16, 2004. It is submitted that these definitions do not fairly state the applicable standard under which obviousness should be determined under 35 USC §103, in that the field of technology should not be defined so broadly as to extend clearly beyond the capabilities of "a person having ordinary skill in the art to which said subject matter pertains". Also, the Examiner's stated common problem of "printing information in more than one layer" is not a problem of either the present invention or of Mowry.

The above analysis also compels the conclusion that the proposed combination of Mowry and Fröhlich is legally untenable under §103, and the rejections based thereupon should be overruled. It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching,

suggestion, or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Fröhlich patent discloses a process and apparatus for conveying printed products 20 in an imbricated stream, and wherein the printed products are laterally displaced so as to expose the side margins of the products. An ink jet writer 34' is provided for applying an address to each product on the exposed side margin.

The Examiner has held that it would have been obvious to use the printing steps of Mowry with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner. To the contrary, the skilled person would surely refrain from doing so, since the Mowry printing operation, which utilizes pressure sensitive frangible capsules which contain the ink forming chemicals, is highly specialized and clearly too expensive for use on mass produced articles such as printed products being conveyed in an imbricated stream. Further, the printing produced by the Mowry process is sensitive to any applied pressure, and this fact would render it clearly unsuitable for use in an imbricated stream of printed products, which are inherently subject to relative movement and rough handling. Thus there not only is no teaching, suggestion, or incentive to support the proposed combination of Mowry and Fröhlich, but in reality, there would be significant incentive not to make the combination.

Claims 8-10 define the method of the invention with more particularity by reciting that the partially transparent contrast panel is printed onto the border region of each product of the imbricated stream, so as to overlie the printing on the printed surface of each product and so as to

allow the underlying printing to be seen through the contrast panel. These claims thus highlight an important feature of the present invention, namely, that both the underlying printed text and the printing on the label can be seen and read.

Dependent Claims 6, 9, and 12 were rejected as being unpatentable over Mowry and Fröhlich as applied above, and further in view of Gurwick. Gurwick was applied in view of its teaching of printing information onto a panel, but the patent fails to supply the deficiencies of the combination of Mowry and Fröhlich as set forth above. Similarly, the prior patent to Reist was applied to reject dependent Claim 14, but Reist also fails to supply the above noted deficiencies of Mowry and Fröhlich.

Claims 5-13 were also rejected as being unpatentable over "A Century of Comics" (as discussed in the article entitled "1933: The First Comic Book") in view of Fröhlich. Also, in connection with this rejection, the Examiner has referred to the article "Understanding Color" for a description of four color printing.

The "1933: The First Comic Book" article refers to the four color printing process and shows several cover pages of comic books with a title and some illustrations. The title is either printed in black on a uniform (presumably colored) background (see "Funnies on Parade" shown on the first page of the article) or it is printed in white on a black or gray background (see "Century of Comics" on the third page of the article).

The Examiner has attempted to equate the printed portions of the referenced comic books with the claimed partially transparent contrast panel and with the claimed printing step. Specifically, the Examiner has taken the position (as best it

can be understood) that the second layer of four color printing permits the original layer of printing to be seen therethrough, and thus the second layer constitutes the claimed partially transparent contrast panel which is applied to a printed surface and that this layer, or a subsequent layer, is printed so as to apply text on the contrast panel.

The Examiner's application of the described comic books to the claimed invention is untenable for the reason that in four color printing, the underlying layer cannot be "seen through" later applied layers. Rather, the printed layers combine to absorb selected wavelengths while reflecting other wavelengths, so as to result in the color we see. This is made clear in the cited Understanding Color article. Thus there is no basis to contend that the "A Century of Comics" publication teaches the use of a partially transparent contrast panel as that term is defined in the present application.

Nor is there any basis to contend that the four color printing process could be employed to apply text to printed products being conveyed in an imbricated stream. In this regard, the present invention starts where "A Century of Comics" ends. The invention teaches that a completed printed product (e.g. a comic book as shown in "A Century of Comics", printed by whatever method) is furnished with a contrast panel applied to the border region of the already finished product, while conveying it in an imbricated formation. Applying a contrast panel in this way is not at all possible while making the "Comics" cover page itself. A four color printing is usually done using a rotary printing press, which requires feeding of single sheets of paper, and such a press would not be able to print on products which are conveyed in an imbricated stream. Therefore, there would have been no

motivation at all to combine "A Century of Comics" with Fröhlich, and in fact this would appear to be technically difficult if not impossible.

The "Century of Comics" article and Fröhlich, even when considered collectively, do not disclose or suggest printing the contrast panel on a border region of the printed product which has a printing thereon, so as to overlie at least a portion of the printing on the border region, as further recited in Claim 8. Furthermore, an apparatus having the features of Claims 11-13 is neither disclosed nor rendered obvious by the "Century of Comics" article and Fröhlich for the same reasons as already discussed.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that the Examiner's rejection of Claims 5-14 is legally untenable, and should be reversed. Such action is solicited.

Respectfully submitted,



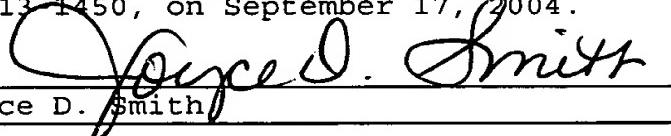
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Joyce D. Smith

APPENDIX

5. A method of providing text on a printed surface of each of a plurality of printed products comprising the steps of

conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap, while

printing a partially transparent contrast panel onto the exposed border region of each printed product, and while

forming information within or on each contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read.

6. The method as defined in Claim 5 wherein the printing step comprises printing the contrast panel onto the printed surface of each printed product as it passes a first printing station along the path of travel, and the forming information step comprises printing the information onto the contrast panel of each printed product as it passes a second printing station along the path of travel.

7. The method as defined in Claim 5 wherein the forming information step includes forming blank areas within the contrast panel, with the blank areas forming the information.

8. A method of providing text on each of a plurality of printed products having printing thereon, comprising the steps of

conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product which has printing thereon is exposed by the imbricated overlap, while

printing a partially transparent contrast panel onto the border region of each printed product so as to overlie at least a portion of the printing on the border region, and so as to allow the printing on the border region to be seen therethrough, and while

forming information within or on each printed contrast panel which forms a contrast with respect to the contrast panel so that the information can be easily seen and read.

9. The method as defined in Claim 8 wherein the forming information step comprises printing the information onto the contrast panel.

10. The method as defined in Claim 8 wherein the forming information step comprises forming blank areas within the contrast panel during the printing step.

11. An apparatus for providing text on a printed surface of each of a plurality of printed products comprising

a conveyor system for conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap,

printing means disposed along the path of travel for printing a partially transparent contrast panel onto the exposed border region of each printed product so as to allow the printed surface of the printed product to be seen therethrough and for forming information within or

on each contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read.

12. The apparatus as defined in Claim 11 wherein the printing means comprises a first printing station disposed along the path of travel for printing the contrast panel, and a second printing station disposed along the path of travel downstream of the first printing station for printing the information onto the contrast panel.

13. The apparatus as defined in Claim 11 wherein the printing means comprises a printing station disposed along the path of travel which acts to print each contrast panel with blank areas, with the blank areas forming the information.

14. The apparatus as defined in Claim 11 wherein the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

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